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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,296

06/25/2007

Juha Telimaa

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EXAMINER

KOLB, NATHANIEL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,296	Applicant(s) TELIMAA ET AL.	
	Examiner NATHANIEL KOLB	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/25/07 and 4/7/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. Claims 1-14 are pending. Claims 1-7 have been canceled. This is a first action on the merits.

Double Patenting (Statutory)

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 8-9 and 13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of copending Application No. 10/590,382 (hereinafter '382). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. **Regarding claims 8 and 13:** The piston is taught in claim 10 of '382. The control system is taught in claim 16 of '382. That the control system enables the piston to be moved to aspirate or dispense liquid is taught in para. 2 of claim 10. That the control system has two setting arrays is taught in claim 16 of '382. Specifically, claim 16 states multiple calibration settings are stored in parallel so that settings according to the current function can be chosen during use. The user interface is taught in claim 10 of '382. The display is taught in claim 10 of '382.

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5. **Regarding claim 9:** Claim 16 of '382 teaches the calibration setting.

Double Patenting (Non-Statutory)

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 10 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 (dependent of claim 10) of copending Application No. 10/590,382. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a menu in this context is obvious. Claim 8 of the application, on which claim 10 is dependent, has been rejected for double patenting as discussed above. Claim 10 then further teaches setting keys. These are referenced by the reference characters of the user interface of claim 10 of '382. Claim 10 of the application also adds the limitation of menus shown on the interface display. In the context of storing settings and choosing between

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multiple functions on a device like this it is obvious that the choices would be made via menus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by SCORDATO et al (US Pat 4,821,586).

10. **Regarding claims 8 and 13:** The piston is taught in col. 1 lines 62-64. The control system to control the volume of liquid dispensed or aspirated is taught in col. 2 lines 5-15. The pipetting setting arrays, which are sets of user defined values stored in the control unit to allow the pipette to function in a certain way, are taught in col. 12 lines 28-35. Specifically, SCORDATO teaches custom programs that the user can write and store on the control unit that define all of the parameters of a routine as shown schematically in FIG. 16.

11. **Regarding claim 9:** There are several pipette functions that can be chosen as part of the user-defined programs as listed in col. 13 lines 56-59. The storage of calibration values is taught in col. 10 lines 66-69.

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12. **Regarding claim 10:** FIG. 16 shows the list of choices for programming the pipette which are chosen by use of the yes and no keys as shown in FIG. 1.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCORDATO et al (US Pat 4,821,586) in view of PETERSON et al (US Pub 2002/0183693).

15. **Regarding claims 11 and 12:** SCORDATO teaches all of the structure in claim 8 as discussed above. However, he does not teach a lock function or password by which the user defined settings can be protected. PETERSON however does teach password protection on his drug dispensing system. Specifically, PETERSON teaches a microprocessor controlled programmable drug pump (abstract) that has lockouts and password protection for the programming function (para. 216). The limitations of claims 11 and 12 of the application are taught in para. 215 where PETERSON teaches that the locks prevent both operating functions and programming (which is equivalent to “changing of the setting array” in the application). Claim 14 of the application adds the limitation that only an authorized person may release the lock which is taught in the password protection of PETERSON (para. 216). These two references are analogous because in both cases there is a microprocessor controlling a fluid handling operation,

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and in both cases the device is programmable to run user-defined routines for handling those fluids. One skilled in the art would be motivated to use the function locks of PETERSON on the programmable pipette of SCORDATO because it keeps unauthorized users from modifying the devices programming (PETERSON para. 213). Therefore the use of a lock function is an obvious limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHANIEL KOLB whose telephone number is 571-270-7601. The examiner can normally be reached on Mon-Thu 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NATHANIEL KOLB/

/Hezron Williams/

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Examiner, Art Unit 2856

Supervisory Patent Examiner, Art
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